

## **REMARKS**

### **Claim Rejections under 35 U.S.C §102**

The Examiner's rejection of claims 25-48 and 50-52 under 35 U.S.C. §102(a) as being anticipated by U.S. Patent No. 6,702,671 to Tarantino, ("Tarantino") is respectfully traversed for at least the reasons given below.

Tarantino is not a §102(a) reference. Tarantino was filed October 23, 2001, and published November 14, 2002. Applicants' application was filed March 5, 2002, before Tarantino's publication date. Thus, the Tarantino application does not itself constitute §102(a) prior art. It was not publicly known or used in the U.S. prior to Applicants' invention filing date. Perhaps the Examiner meant to rely on Tarantino as a §102(e) reference and Applicants have considered it on that basis.

Applicants' claims introduce a variation of a Keno game with an abundance of locations (spots, reels, etc.), where a player can select which locations will be used for a gameplay condition to ultimately determine an outcome. At the outset -- and this is an important distinction -- the player selects *multiple* locations for a gameplay condition. After the player selects the locations (or reels), the locations are played (e.g., the reels are spun) to reveal the game element indicia for the respective location.

Tarantino is a dice game and gaming system. The player of Tarantino attempts to obtain a predetermined combination of indicia, either in sequence or in linked or connected relationship (col. 9, lns. 15-19). Although the Examiner cites Tarantino at col. 13, lns. 53-60 for the proposition that a player selects game element locations, in fact, this disclosure of Tarantino is for demonstrating indicia positions or arrangements, not how selections are made.

Tarantino discloses player selection of a first and single game element location to be played at col. 12, lns. 58-64. The player places a first bet and then is entitled to select *one* single location to be displayed (col. 12, lns. 52-53). The player may then place a second bet to select a second single location (col. 12, lns. 61-63). This embodiment is a successive or sequential play of the same game.

This embodiment, as disclosed in Tarantino, differs and teaches away from the present invention. Most distinctive, Tarantino requires a bet prior to *each* successive selection of only *one* location. The player in Tarantino can “continue to place additional bets and make additional selections in an attempt to receive a winning outcome which results in a higher reward” (col. 13, lns. 2-5). In contrast, Applicants’ game is a variation of Keno in which the player places a wager once and prior to gameplay. Once the player’s wager is placed, the player selects a group of locations to be played, unlike Tarantino’s selection of only one location. After the player selects the locations in Applicants’ invention, the locations are played to reveal the game element indicia for the group of player selected locations. After the indicia are revealed, a payout, if any is determined and the game is over. There is no seriation placement of another wager for another single location as disclosed in Tarantino (col. 12, lns. 52-53).

For the reasons stated above, Tarantino fails to disclose each and every element of the independent claims 25, 29, 39, 47 and 50 and dependent claims thereon. Thus, these claims cannot be anticipated by Tarantino. Accordingly, it is respectfully requested the rejection be withdrawn.

**Claim Rejections under 35 U.S.C §103**

The Examiner's rejection of claims 25-48 and 50-52 under 35 U.S.C. §102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 5,401,024 to Simunek, ("Simunek") is respectfully traversed for at least the reasons given below.

Simunek discloses a Keno-type video gaming device where randomly selected spots on a punch board are compared to player selected spots to determine if there are any matches (col. 3, lns. 50-54). A payout is determined on the number of matches between the player selected spots and the microprocessor's randomly selected spots (col. 1, lns. 15-25). Quite simply, Applicants' invention does not have randomly selected game element *spots or locations*. Random selection of *indicia* is part of Applicants' invention (to display one indicia from a set of indicium) *after* the player selects the game element locations to be played. Applicants do not employ randomly selected locations to determine if there are any matches.

The Examiner's position that the machine's capability "of selecting randomly 'some or all' locations indicates the possibility of selecting 'all' spots by the machine" is not understood (Office Action, p. 3), because it is not relevant to the invention. The player of Simunek selects up to 10 spots and then the microprocessor randomly selects 20 spots (col. 3, lns. 45-49). If there are matches between player selected spots and random selected spots then, "some or all of the matched spots are changed to appear on the CRT as video slot machine reels" (col. 3, lns. 52-54). Applicants have the player select "spots" (i.e., locations), which are then spun to determine whether any will ultimately have winning (e.g., matching) indicia.

For the reasons stated above, Simunek, alone (or even in combination with Tarantino, which combination the Examiner has not asserted as to these claims) fails to disclose each and

every element of the independent claims 25, 29, 39, 47 and 50 and dependent claims thereon.

Accordingly, it is respectfully requested the rejection be withdrawn.

The Examiner further rejected claims 37-38 and 44-46 under 35 U.S.C. § 103(a) as unpatentable over Simunek in view of Tarantino. The Examiner's rejection is respectfully traversed.

Claims 37-38 ultimately depend from independent claim 29 and claims 44-46 ultimately depend from claim 39. Since independent claims 29 and 39 should be allowable for the reasons above, then claims 37-38, 44-46 should also be allowable since they are dependent claims of an allowable claim.

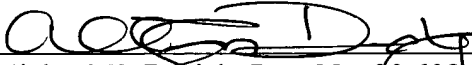
Therefore, for at least the foregoing reasons, reconsideration of the rejections is respectfully requested. A Notice of Allowability is solicited.

If the Examiner maintains his rejections after considering the foregoing, Applicants respectfully request an interview to further clarify the arguments stated herein.

Respectfully submitted,

Date: May 17, 2005

Baniak Pine & Gannon  
150 North Wacker Drive  
Suite 1200  
Chicago, Illinois 60606-1606  
(312) 673-0360

  
Michael H. Baniak, Reg. No. 30,608  
Allison M. Dudley, Reg. No. 50,545  
Attorneys for Applicants